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09/847,224	05/02/2001	William V. Harding	2063.002300	5963

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EXAMINER

ELDRED, JOHN W

ART UNIT PAPER NUMBER

3644

DATE MAILED: 07/15/2003

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/847,224
Filing Date: May 02, 2001
Appellant(s): HARDING, WILLIAM V.

MAILED

JUL 15 2003

GROUP 3600

Jeffrey A. Pyle
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6-2-03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because he states that not all claims are rejected as vague and indefinite. This is incorrect since all claims are rejected under 35 U.S.C. 112, Paragraph 2 because all claims in the case either contain the phrase "determining a pattern" or depend from a claim which contains that phrase.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,043,867	SABAN	3-2000
5,631,653	REEDY	5-20-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-75 are rejected under 35 U.S.C. 112, 2nd paragraph. This rejection is set forth in prior Office Action, Paper No. 8.

Claims 1-75 rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office Action, Paper No. 8.

(11) Response to Argument

The first argument Applicant makes, is that the phrase “determining a pattern” should not be held indefinite. Applicant’s basis argument is that the phrase must be read in light of the specification and, he concludes, that this would make the claims definite. Applicant quotes the definition of “pattern” from a dictionary and states that, in view of the specification, “spurious definitions of pattern” could be eliminated. He also dismisses a question from the Examiner’s earlier 112 rejection as rhetorical and fails to address the issues raised by that question. Specifically, the question “What is forming the pattern and what type of pattern is being formed?” is not addressed and he goes on to state that it “is readily apparent in the context of the art and in light of the specification that the “pattern” is a “search pattern.”” This definition of “pattern” as used in the rejected claims is clearly a case of importing limitations from the specification into the claims, when such a limitation is not supported by the claim language and alternative interpretations consistent with the specification is available. “Determining a pattern” is so vague and indefinite that one of ordinary skill in the art could not reasonably determine the metes and bounds of the claim protection. The Examiner’s earlier question was not rhetorical, because it is precisely information such as what elements are forming a pattern, and what type of pattern is being formed, that must be included in order to establish the limits of the claim. In opposition to Applicant’s assertion that it is “readily apparent” that the pattern is a “search pattern”, the Examiner would conclude that it is just as apparent that the pattern could be the

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“pattern of movement of a target.” Another obvious alternative, which is also consistent with the specification (see page 10, lines 1-2), is that the pattern is a “target recognition pattern” since target recognition is a part of the specification, and it is very well known in the art that patterns are commonly used in such recognition schemes.

A second argument made by Applicant is that “assuming a value” is not indefinite in claims 2, 19, and 51, each of which depend from a claim in which the value being assumed was claimed as already being “ascertained.” Applicant basically argues that “assuming” can be used in the process of “ascertaining” a value. This argument misses the point, as noted in Paragraph 6 of the final Office Action. The Examiner acknowledges that “assuming” can be a part of the process of ascertaining a value. The problem is that it is improper and confusing to claim the process of “assuming” the value after it has been claimed as “ascertained.” The definitions of “ascertain” or “ascertained” clearly involve the determination of something, i.e. the “value”, by experimentation or examination. While these experimentations or examinations can involve making assumptions, to later claim the assuming of an already determined value leaves the person attempting to interpret the claim unsure as to the process involved and the definiteness of the “value” and the uses to which it is being put to in the claims.

A third argument is directed towards the alternative language of claims 6, 23, 59, 67, and 69. The form of each of these claims fails to make clear if only one of the alternative possibilities are to be chosen, or if more than one must or could fulfill the claims.

A fourth argument is that the 102(b) rejections fail to disclose all claimed elements. These references have been applied as art which shows all claimed elements, when the claims are read in view of the very broad and indefinite claim language noted above. The heart of the invention, as claimed, is “autonomously determining a pattern from the ascertained target information” and since the language allows no precise determination of what pattern is being determined, the prior art is believed to read over the language of the claims. For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



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Primary Examiner
Art Unit 3644

JWE
July 10, 2003

Conferees

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